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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,360	12/28/1999	SOON-JIN KIM	678-427-(P89)	9893
7590	02/05/2004		EXAMINER	NGUYEN, TU X
PAUL J FARRELL ESQ DILWORTH AND BARRESE 333 EARLE OVINGTON BOULEVARD UNIONDALE, NY 11553			ART UNIT	PAPER NUMBER 18
DATE MAILED: 02/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/473,360	KIM, SOON-JIN
	Examiner Tu X Nguyen	Art Unit 2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12/3/03.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Disposition of Claims

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____ .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>17</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

1. Applicant's arguments, filed 12/3/03, with respect to claims 1 and 5 have been discussed in the previous rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonsson et al. (US Patent 6,385,585).

As to claim 1, Jonsson et al. disclose a method for transmitting a character message in a mobile communication terminal while maintaining a conversation by telephone (see col.10 lines 32-39), the examiner interprets "during an ongoing conversation" reads on "while maintaining conversation", comprising the steps of:

Setting the mobile communication terminal to a character message-transmitting/receiving mode while in a state in which a speech path has been established between the mobile communication terminal and a mobile communication terminal of a party other than the user (see col.3 lines 46-67); and

inputting a character message while in the character message-transmitting/receive mode, processing the written character message and transmitting the written character message in character format to the communication terminal of the other party via the established speech path in the character message-transmitting/receiving mode (see col.3 lines 1-12, col.5 lines 29-50, col.6 lines 30-42 and col.10 lines 32-35).

As to claim 2, Jonsson et al. disclose returning the mobile communication terminal of the user to a phone mode after the transmission of the character message to the mobile communication terminal of the other party (see col.11 lines 38-44).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Makela et al. (US Patent 6,301,338).

As to claim 3, Jonsson et al. fail to disclose the character message input during the character message-transmitting/receiving mode is selected among character messages previously written and stored in a registered state.

Makela et al. disclose the character message input during the character message-transmitting/receiving mode is selected among character messages

previously written and stored in a registered state (see col.5 lines 44-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Makela et al. in order to provide user conveniently to transmit pre-stored messages to other party.

6. Claims 4-5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Svensson (US Patent 5,687,216).

As to claim 4, Jonsson et al. fail to disclose receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message.

Svensson discloses receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message (see col.6 lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Svensson in order to provide another message is received before the users reads the current message (as suggested by Svensson, see col.6 lines 1-7).

As to claim 5, the modified Jonsson et al. disclose all limitations as to claims 1 and 4 above.

Conclusion

7. This is a 09/473,360 of applicant's earlier Application No. 09/473,360. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is (703) 305-3427. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7749.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

TN

January 13, 2004

Nay Maung
NAY MAUNG
SUPERVISORY PATENT EXAMINER